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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,592	07/24/2001	Ralph S. Hoefelmeyer	COS00019	3657
25537 7590 11/02/2007 VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD SUITE 500 ARLINGTON, VA 22201-2909			EXAMINER CHEN, SHIN HON	
			ART UNIT 2131	PAPER NUMBER
			NOTIFICATION DATE 11/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/911,592

Applicant(s)

HOEFELMEYER ET AL.

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/15/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 have been examined.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3, 5, 8, and 10 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 4, 7, 11 and 14 of copending Application No. 10/024,202. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: co-pending applications and present application disclose a scanning system, an anti-virus server, and a switch for performing the same virus protection procedures.

The instant claims are broader in scope to the claims for co-pending application and are therefore obvious/anticipated from them.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 6, 8 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hypponen et al. U.S. Pub. No. 20030191957 (hereinafter Hypponen) in view of Yanovsky U.S. Pat. No. 7010807 (hereinafter Yanovsky).

6. As per claim 1, 5, 8, and 10,, Hypponen discloses a network security system to be deployed between a plurality of network (intranet) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the network (intranet) for scanning incoming electronic mail for malicious code (Hypponen: [0011]: virus scanning server), and a switch coupled between the internet backbone and the scanning system (Hypponen: figure 1 and [0012] and [0013]: transit nodes 4a); said switch configured for: directing incoming electronic mail from the internet backbone to the scanning system (Hypponen: [0008]-[0009]: directing the data from transit node to scanning server). Hypponen does not explicitly disclose an anti-virus server coupled to the network (intranet) for downloading anti-virus code to clients coupled to the network (intranet). However, Yanovsky discloses an internet access module for updating anti-

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virus protection on network devices by periodically updating network devices (Yanovsky: column 1 line 66 – column 2 line 11). It would have been obvious to one having ordinary skill in the art to utilize the internet access module/anti-virus server and the scanning server as an anti-virus system to be coupled to a transit node/switch because providing virus scanning and virus code update are well known features of anti-virus systems and both prior art discloses protection of local area network/intranets. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Yanovsky within the system of Hypponen because it ensure anti-virus software residing on network devices are up-to-date (Yanovsky: column 2 lines 10-11).

Furthermore, although Hypponen does not explicitly discloses the switch is coupled to a plurality of intranets, Hypponen discloses the users (2a-2d) includes number of workstations, servers and administrators, each of which could potentially serve in another intranet as one with ordinary skill in the art would understand (Hypponen: [0031] and figure 1). Therefore, it would have been obvious to one having ordinary skill in the art to apply the intranet anti-virus system to plurality of intranets to reduce the cost of implementing a separate system for each intranet.

7. As per claim 3, Hypponen discloses a network security system to be deployed between a plurality of network (intranet) belonging to respective organizations and an internet backbone, comprising: a scanning system coupled to the network (intranet) for scanning incoming electronic mail for malicious code (Hypponen: [0011]: virus scanning server); a mail proxy server for determining whether the incoming electronic mail is to be scanned for malicious code and directing the incoming electronic mail to the scanning system when the incoming electronic mail is determined to be scanned for malicious code (Hypponen: [0032] and [0036]: the data is

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routed from Internet via firewall 4a to mail server); and a switch coupled between the internet backbone, and the scanning system (Hypponen: figure 1 and [0012] and [0013]: transit nodes); said switch configured for: directing incoming electronic mail from the internet backbone to the mail proxy server (Hypponen: [0032]: pass data from firewall to mail server). Hypponen does not explicitly disclose an anti-virus server coupled to the network (intranet) for downloading anti-virus code to clients coupled to the network (intranet). However, Yanovsky discloses an internet access module for updating anti-virus protection on network devices by periodically updating network devices (Yanovsky: column 1 line 66 – column 2 line 11). It would have been obvious to one having ordinary skill in the art to utilize the internet access module/anti-virus server and the scanning server as an anti-virus system to be coupled to a transit node/switch because providing virus scanning and virus code update are well known features of anti-virus systems and both prior art discloses protection of local area network/intranets. Furthermore, although Hypponen does not explicitly disclose the switch is coupled to a plurality of intranets, it would have been obvious to one having ordinary skill in the art to apply the intranet anti-virus system to plurality of intranets to reduce the cost of implementing a separate system for each intranet. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Yanovsky within the system of Hypponen because it ensure anti-virus software residing on network devices are up-to-date (Yanovsky: column 2 lines 10-11).

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8. As per claim 6 and 11, Hypponen as modified discloses the network security system according to claims 5 and 10 respectively. Hypponen as modified further discloses load-balancing among the scanning systems and proxy servers (Hypponen: [0043]).

9. As per claim 12-15, Hypponen as modified discloses the system of claims 1, 3, 8, 10 respectively. Hypponen as modified further disclose a hub in communication with the scanning system and the intranets, wherein the scanning system is further configured for sanitizing at least some of the incoming electronic mail addressed to recipients on the intranets and directing the sanitized incoming electronic mail to the recipients via the hub (Hypponen: [0038] and [0042]: disinfect the files)

10. Claims 2, 4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hypponen in view of Yanovsky and further in view of Network Associates, Inc. "Network Associates Ships Cybercop Sting- Industry's first 'Decoy' Server Silently Traces and Tracks Hacker Activity" (hereinafter NAI).

11. As per claim 2, 4, 7, and 9, Hypponen as modified discloses the system of claims 1, 3, 5, and 8 respectively. Hypponen as modified does not explicitly disclose a decoy server coupled to the intranets for masquerading as a legitimate server and logging activity on communications received via the internet backbone; wherein the switch is further coupled to the decoy server and is further configured for redirecting suspicious traffic from the internet backbone to the decoy server. However, NAI discloses decoy server is used to trace and track hackers and reporting all

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intrusive activities (NAI: page 1). It would have been obvious one having ordinary skill in the art to include decoy server into the anti-virus system because Hypponen and NAI both are applied within a network anti-virus environment. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of NAI within the combination of Hypponen-Yanovsky because it provides additionally security measure to web clients.

Response to Arguments

12. Applicant's arguments filed on 8/15/07 have been fully considered but they are not persuasive.

Regarding applicant's argument on double patenting rejection, an earlier patent is not patentably distinct from a later patent claim if the later claim is obvious over, or anticipated by, the later claim. In this application, claims 1, 3, 5, 8, and 10 are generic to the species of invention covered by claims 1, 4, 7, 11 and 14 of the patent/application #10/024,202. Thus, the generic invention is "anticipated" by the species of the patent/application #10/024,202. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim). This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In *re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claim(s) XX were properly rejected under the doctrine of obviousness-type double patenting. " (In *re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993)).

Regarding applicant's remarks, applicant mainly argues that prior art of record does not discloses plurality of intranets. However, as previously stated in the office action, Hypponen discloses plurality of users (figure 1: 2a-2d and [0031]), although they are connected through network 3, one with ordinary skill in the art would understand that each could be connected to another intranet to form plurality of intranets. Therefore, the idea of expanding the security system from one intranet to plurality of intranets does not render the application novel from prior art of record. Therefore, applicant's argument is respectfully traversed.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shin-Hon Chen
Examiner
Art Unit 2131

SC


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